

IPLM Group, P.A.
P.O. Box 18455
Minneapolis, MN 55418
612-331-7400 telephone
612-331-7401 facsimile



AF 3724
PATENT

TRANSMITTAL LETTER

| Attorney Docket No. | Serial No. |
|---------------------|------------|
| 127P67USC1 | 09/995,009 |

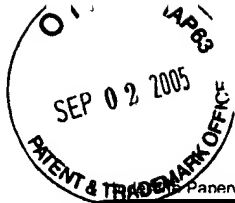
MS: Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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|---|--------------------------------------|-----------|--------------|
| In re Application of: | David B. Miller | | |
| Serial No.: | 09/995,009 | Examiner: | Essama Omgba |
| Confirmation No.: | 1384 | Art Unit: | 3726 |
| Filed: | November 26, 2001 | | |
| For: | PRE-ASSEMBLED HOSE AND RING ASSEMBLY | | |
| We are transmitting the following documents: Return Postcard Transmittal Letter [1 page] Fee Transmittal for FY 2005 [1 page] Credit Card Payment Form [1 page] Appeal Brief (including Appendix) [14 pages] | | | |

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Respectfully submitted,

| | | |
|---|-----------------------------|--|
| Registration No. 30,087 | Direct Dial 612-331-7415 |  |
| Date: August 31, 2005 | | Michael L. Mau |
| United States Patent and Trademark Office Customer No. 23322 | | |
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|---|--|--------------------------|-------------------|
| Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). FEE TRANSMITTAL For FY 2005 | | Complete if Known | |
| <input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27 | | Application Number | 09/995,009 |
| TOTAL AMOUNT OF PAYMENT (\$) 500 | | Filing Date | November 26, 2001 |
| | | First Named Inventor | David B. Miller |
| | | Examiner Name | Essama Omgba |
| | | Art Unit | 3726 |
| | | Attorney Docket No. | 127P67USC1 |

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

| Application Type | FILING FEES | | SEARCH FEES | | EXAMINATION FEES | | Fees Paid (\$) |
|------------------|-------------|-----------------------|-------------|-----------------------|------------------|-----------------------|----------------|
| | Fee (\$) | Small Entity Fee (\$) | Fee (\$) | Small Entity Fee (\$) | Fee (\$) | Small Entity Fee (\$) | |
| Utility | 300 | 150 | 500 | 250 | 200 | 100 | |
| Design | 200 | 100 | 100 | 50 | 130 | 65 | |
| Plant | 200 | 100 | 300 | 150 | 160 | 80 | |
| Reissue | 300 | 150 | 500 | 250 | 600 | 300 | |
| Provisional | 200 | 100 | 0 | 0 | 0 | 0 | |

2. EXCESS CLAIM FEES

| Fee Description | Fee (\$) | Small Entity Fee (\$) |
|---|-----------------|-----------------------|
| Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent | 50 | 25 |
| Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent | 200 | 100 |
| Multiple dependent claims | 360 | 180 |
| Total Claims | Fee (\$) | Fee Paid (\$) |
| _____ - 20 or HP = _____ x _____ = _____ | | |
| HP = highest number of total claims paid for, if greater than 20 | | |
| Indep. Claims | Fee (\$) | Fee Paid (\$) |
| _____ - 3 or HP = _____ x _____ = _____ | | |
| HP = highest number of independent claims paid for, if greater than 3 | | |

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets _____ **Extra Sheets** _____ **Number of each additional 50 or fraction thereof** _____ **Fee (\$)** _____ **Fee Paid (\$)** _____
_____ - 100 = _____ / 50 = _____ (round up to a whole number) x _____ = _____

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other: Appeal Brief

500

SUBMITTED BY

| | | | | | |
|-------------------|----------------|-----------------------------------|-----------------|-----------|--------------|
| Signature | | Registration No. (Attorney/Agent) | 30,087 | Telephone | 612-331-7415 |
| Name (Print/Type) | Michael L. Mau | Date | August 31, 2005 | | |

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

| | | | |
|-----------------------|--------------------------------------|-----------------|------------|
| In re Application of: | David B. Miller | Examiner: | E. Omgba |
| Serial No.: | 09/995,009 | Group Art Unit: | 3726 |
| Confirmation No.: | 1384 | Docket No.: | 127P67USC1 |
| Filed: | November 26, 2001 | | |
| Title: | PRE-ASSEMBLED HOSE AND RING ASSEMBLY | | |

APPEAL BRIEF

Mail Stop: Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is an appeal from the Final Rejection mailed May 17, 2005 rejecting claims 7 and 8. The Notice of Appeal was filed via facsimile on July 11, 2005. Accordingly, the due date for this Appeal Brief is September 11, 2005. The fee required under 37 CFR §41.20(b)(2) for the appeal should be charged to Deposit Account No. 50-0549.

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REAL PARTY IN INTEREST

The real party in interest is The Toro Company, the assignee of the patent application, as evidenced by the Assignment recorded on April 1, 2002 at Reel 012778, Frame 0555.

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RELATED APPEALS AND INTERFERENCES

Appellant, Appellant's legal representative, and the assignee are not aware of any appeals or interference proceedings before the U.S. Patent and Trademark Office that will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

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STATUS OF CLAIMS

Claims 1-8 were filed with the parent application on April 12, 2001, which claims the benefit of a provisional application filed April 14, 2000. In an Office Action mailed November 19, 2003, claims 7 and 8 were rejected. An Amendment was filed on February 18, 2004 amending claim 7 and adding claim 9. Claims 1-6 were withdrawn. On November 12, 2004 claim 7 was further amended and claim 9 withdrawn, leaving only claims 7 and 8. Claims 7 and 8 were rejected in a Final Office Action mailed May 17, 2005. Claims 7 and 8 are pending. This appeal followed, and claims 7 and 8 are the claims being appealed.

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STATUS OF AMENDMENTS

No Amendments have been filed subsequent to the final rejection of claims 7 and 8.

The Appendix containing a listing of the claims involved in the appeal incorporate all of the amendments made by Appellant.

SUMMARY OF CLAIMED SUBJECT MATTER

A concise explanation of the invention for each of the independent claims involved in the appeal is as follows:

Claim 7

Claim 7 recites a method of making a clip in an irrigation hose assembly. A plurality of clips, having a body with an opening, are secured at spaced intervals on an irrigation hose having an outer surface. The clips are secured at the factory by enlarging the opening to allow the clips to be inserted on the hose and then releasing the clip to secure the clip to the hose. The clips have an inner diameter sized and configured to be secured around the hose and also to be moveable on the hose, wherein the clip is in contact with the outer surface of the hose. The clips and hose are coiled, whereby the assembly of the clips and hose are able to be shipped to a site for subsequent installation by suspending the clips (and thereby the attached hose) from a wire. As stated on page 5, lines 25-29, the preassembling of the clips of the factory eliminates the labor at the site. Previously, as described on page 1, lines 14-19, the hose has been delivered to the site where it is unwound and the clips are manually attached to the hose. Then the wire is secured to the clip to hang the dripper line hose for subsequent use during irrigation. The process is slow and expensive and requires substantial labor to install the clips over the hundreds of feet of hose.

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GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 7 and 8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (AAPA) in view of Oetiker (U.S. Patent 5,321,879) or Oetiker (U.S. Patent 4,425,781).

ARGUMENTS

Rejection under 35 U.S.C. 103(a) over AAPA in view of U.S. Patent 5,321,879 or 4,425,781 to

Oetiker

Claims 7 and 8

AAPA is delivering a wound hose to a site where the hose is unwound, the clips applied, and then the clips hung from a wire, with the hose attached to the clips.

The clips in the prior art were used to hang the hose from a wire. This is a very labor intensive process to, in the field, attach the clips individually to the hose. This has been a long standing problem in the industry. In fact, since the introduction of the present invention, several competitors have copied the invention and are now using a preassembly approach. This is further evidence of the non-obviousness of the present invention. The clips of the present invention further are used to act as drip locators. The irrigation water that is coming out of a hole in the hose is emitted quite slowly. The drips of water will follow along the hose and if they come into contact with a clip, will then drop from the hose onto the ground. Therefore, by locating the clips in a certain location, the water from the irrigation hose may be properly directed.

The first Oetiker patent, U.S. Patent No. 4,425,781 is directed towards a method of manufacturing hose clamps. Column 4, lines 38-47 appear to be directed towards the installation of a clamp on an object. That clamp may then be later tightened during an assembly process. Referring to column 10, line 33, the patent states "Secure tightening of the clamp or of several clamps may then be carried out by another person appropriately located along the assembly line with the use of suitable pneumatic pincers or also by the person performing the performing and preassembly operations." It would therefore appear that this patent is directed towards a manufacturing process where the hose clamps, which are not at all related to an irrigation hose, are assembled in a

manufacturing operation in a factory. Similarly, the second patent, U.S. Patent No. 5,321,879, it is seen in the background of the invention, that the clamps are applicable to an assembly line in the automobile industry to fasten axle boots onto axles. Again, this is not at all related to an irrigation hose.

Applicant respectfully traverses the *prima facie* obviousness rejection of the Examiner. In order for a *prima facie* case of obviousness, there must be basis in the art for combining or modifying the references. The references are totally diverse. The admitted prior art deals with the manufacturing of an irrigation hose that is coiled and shipped off to a farm for later installation for irrigation purposes. The cited references are directed towards a clamp that is utilized during an assembly operation, typically in an automobile factory. Applicant respectfully submits that there is no teaching in the references that would suggest to one of ordinary skill in the art to make the proposed combination or modification suggested by the Examiner. There must be some logical reason that would justify the combination or modification. There would be no justification for a person skilled in the art of manufacturing an irrigation hose to utilize a clamp used in an automobile assembly operation.

There is no off-site use suggested by the cited references. Applicant can find no reason why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention. There is no suggested relationship between the admitted prior art and that of the cited references that would cause one to combine the references as suggested.

The references by themselves must suggest a reason for the combination. One should not base an obviousness rejection upon what a person skilled in the art might try or might find obvious to try, but rather what the prior art would have led a person skilled in the art to do. Applicant respectfully submits that there is no suggestion in the prior art that would lead one skilled in the art to make the combination suggested by the Examiner.

In further support of this is the fact that the Oetiker references are non-analogous art with respect to a person manufacturing irrigation hose.

Section 103 requires us to presume full knowledge by the inventor of the prior art in the field of his endeavor, but it does not us to require full knowledge by the inventor of prior art outside the field of his endeavor. In that respect it would only require us to presume that the inventor would have an ability to select and utilize knowledge from other arts reasonably pertinent to his particular problem which would be expected of one of ordinary skill in the art to which the subject matter pertains. Applicant respectfully suggests that this is the case in the present matter and that the reference should not be applied.

In addition, the prior art does not teach the source of the problem. The Oetiker references could not even begin to suggest the problem of attaching an irrigation hose when the Oetiker patents have to do with a non-analogous use of a clamp for automobile hose assembly operations. The present claimed invention addresses the problem of increased labor in the field while attaching clips to the hose, while in the field. The Oetiker patents are unrelated. Further, the Oetiker patent does not address spacing any clamps at intervals for later attaching the clamps to a wire.

Finally, the proposed combination, even if made, would not work. The clips of the Oetiker reference would not be useful if used on the present invention. In the '879 patent, at column 2, lines 19-38 (as cited by the Examiner) the patent claims that the "clamp is so mounted over the axle boot at the transfer station that it will stay in a predetermined position." It can therefore been seen that the clamps are not sized and configured to be "moveable on the hose" as recited in claim 7. If the clamps of the Oetiker patent were used, they would not be adjustable and the drips of water could not be precisely located as is required in the irrigation art. Further, the wire which supports the hose is supported by posts. If the clips are not moveable, they may be positioned over a post and not be able to be used. Therefore, such a proposed combination would simply

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not work in the irrigation field, as would be expected as the Oetiker patent is non-analogous to the present claimed invention.

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CONCLUSION

In view of the aforesaid reasons, and those advanced during prosecution to date, the Appellant requests that the Examiner's rejections be reversed.

Respectfully submitted,

DAVID B. MILLER

Date: 8-30-05

By: 

Michael L. Mau
Reg. No. 30,087
IPLM Group, P.A.
P.O. Box 18455
Minneapolis, MN 55418
Telephone: (612) 331-7415

MLM:db

APPENDIX

LISTING OF CLAIMS

7. A method of making a clip and irrigation hose assembly comprising:
 - a) securing a plurality of clips having a body with an opening at spaced intervals on an irrigation hose having an outer surface at a factory by enlarging the opening to allow the clip to be inserted on the hose and then releasing the clip to secure the clip to the hose the clip having an inner diameter sized and configured to be secured around the hose and also be moveable on the hose, wherein the clip is in contact with the outer surface of the hose; and
 - b) coiling the clips and hose, whereby the assembly of clips and hose are able to be shipped to a site for subsequent installation by suspending the clips from a wire.
8. The method of claim 7, further comprising securing the clips to the hose by an automatic process.